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JUL 27 2006

REMARKS

Applicant submits with this response a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002. Applicant has amended Claims 1 and 3. No new matter has been added.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1, 3, and 6-12 stand rejected under 35 U.S.C. § 102(e) for anticipation by Chen et al. (U.S. 6,773,102). US Patent 6,773,102 was filed September 27, 2002. Applicant submits with this response a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002, thereby rendering this rejection moot.

The prior submitted affidavit was rejected as being ineffective because “in the exhibit submitted ... there is no disclosure in the lab notebook pages that the binder is an aqueous emulsion polymer having a glass transition temperature of from 40 to 80°C.” While the Examiner acknowledged that the 1.131 declaration itself stated that the binder is an aqueous emulsion polymer having a glass transition temperature of from 40 to 80°C, the affidavit was rejected because the lab notebook pages “only generically refer to ‘binder’, to support such statement.” Applicant submits that this rejection of the prior affidavit was in error and contrary to established case law. Nevertheless, Applicant has submitted a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002, whereby the Tg is set forth in the lab notebook pages.

M.P.E.P. § 715.07 states that (emphasis added) “when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and “notes.” An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).” This statement in M.P.E.P. § 715.07 derived from the language in *Ex parte Ovshinsky*, which states:

“This failure to give probative weight to the Rule 131 declarations constitutes reversible error. We point out to the examiner that (1) all the evidence must be considered in its entirety, including the Rule 131 declarations and accompanying exhibits, records and “notes”, (2) an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by the declaration itself. *Ex parte Swaney*, 89 USPQ 618 (PO Bd.App. 1950), and (3) it is entirely appropriate for appellants to rely on a showing of facts set forth in the Rule 131 declarations themselves to establish conception of the invention prior to the effective date of the reference. This appellants have done.”

For the above reasons, Applicant submits that this rejection of the prior affidavit was in error and contrary to established case law. Nevertheless, Applicant has submitted a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002, whereby the Tg is set forth in the lab notebook pages.

Claims 1, 3, and 6-10 stand rejected under 35 U.S.C. § 102(b) for anticipation by Patel et al. (U.S. 5,977,210) taken in view of the evidence given in Sasaki et al. (U.S. 4,248,636) and Satake et al. (U.S. 5,814,685). Applicant respectfully disagrees. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). Patel et al. teaches the aggregation of pigments and polymers requiring the use of cationic surfactants to accomplish agglomeration. (Column 3, line 26-36 and 46-47, and also Figure 1). Claims 1 and 3 cover the use of anionic or nonionic surfactants only. The Examiner's rejection in paragraph 5 of the office action mailed 11/28/05 erroneously states that anionic or cationic surfactants are described in Patel et al. In fact, an anionic surfactant is always coupled with a cationic surfactant (Column 3, lines 28, 47, 54 and 62). To do otherwise would render Patel et al. non-functional because the cationic surfactant is necessary to accomplish agglomeration.

The Examiner also stated that while Patel et al. requires the use of cationic surfactant, "in light of the open language of the present claims, i.e. 'comprising', the scope of the claims is clearly open to the inclusion of additional ingredients including cationic surfactant." Applicant maintains that this reading of "comprising" is inconsistent with established case law. M.P.E.P. § 2111.03 states that (emphasis added) "the transitional term 'comprising' ... is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." It goes on to state that "comprising ... means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim." It further states that "In contrast, the court noted the phrase 'group consisting of' is a closed term, which is often used in claim drafting to signal a 'Markush group' that is by its nature closed. Additionally, case law has stated that "comprising is not a weasel word with which to abrogate claim limitations." *Spectrum Int'l. Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1380 (Fed. Cir. 1998). The present claims comprise a surfactant element which is "selected from the group of anionic and nonionic surfactants." To state that this claim is open to the inclusion of cationic surfactants is inconsistent with established case law.

Moreover, Patel et al. fails to teach what, if any, water-soluble surface agents are needed to adhere to hydrophobic surfaces as opposed to other surfaces and what Tg levels to select for the aqueous emulsion polymer. Patel et al. fails to disclosure each and every element of the claimed invention, arranged as in the claim.

Claims 1, 3, and 6-12 stand rejected under 35 U.S.C. § 102(b) for anticipation by Cheng et al. (U.S. 6,239,193) taken in view of the evidence given in Milne (U.S. 4,849,286). Applicant respectfully disagrees. Cheng et al. does not disclose printing on a hydrophobic substrate. The transparency material disclosed in Cheng et al. is a “transparency material suitable for aqueous ink jet inks or ink jet printing” (col. 15, lines 33-38). The term “suitable for aqueous ink jet inks or ink jet printing” means a coated substrate which has been treated to accept an aqueous ink jet ink. The term transparency as used in Cheng et al., therefore, refers to a coated substrate for receiving an aqueous ink jet ink, not a hydrophobic substrate. In fact, Milne, which is being relied upon for a description of a transparency, exemplifies a treated surface to make it hydrophilic for acceptance of an aqueous ink jet ink (abstract).

Claims 1, 3 and 6-12 stand rejected under 35 U.S.C. § 102(e) for anticipation by Wang et al. (U.S. 2004/0063807). US Patent application, published as US 2004/0063807, was filed September 27, 2002. Applicant submits with this response a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002, thereby rendering this rejection moot.

#### ***Claim Rejections – 35 U.S.C. § 103***

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. (U.S. 6,773,102) or Patel et al. (U.S. 5,977,210) either of which in view of Miyabayashi et al. (U.S. 2002/0107303). US Patent 6,773,102 was filed September 27, 2002. Applicant submits with this response a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002, thereby rendering this rejection moot with respect to Chen et al.

For the reasons provided above, the disclosure of Patel et al. differs from Applicant's invention by more than just the requirements of a specific type of substrate. Moreover, an obviousness rejection is improper where the proposed modification of the references would destroy the intended function of the references. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose). The use of only an anionic or nonionic surfactant would destroy the function of agglomeration sought in Patel et al. Patel et al., as a whole, teaches

a method of agglomerating pigments and polymers requiring the use of cationic surfactants to accomplish agglomeration, not formulating an inkjet ink for printing on a hydrophobic substrate. Patel et al. fails to teach what, if any, water-soluble surface agents are needed to adhere to hydrophobic surfaces as opposed to other surfaces and what Tg levels to select for the aqueous emulsion polymer. One skilled in the art would not know what formulating ingredients are important for printing on a hydrophobic substrate given the teachings of Patel et al. Moreover, Patel et al. requires the use of cationic surfactants and Applicant excludes cationic surfactants.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng et al. (U.S. 6,239,193) or Wang et al. (U.S. 2004/0063807) either of which in view of Miyabayashi et al. (U.S. 2002/0107303). Applicant respectfully disagrees. US Patent application published as US 2004/0063807 was filed September 27, 2002. Applicant submits with this response a second Affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the invention prior to September 27, 2002, thereby rendering this rejection moot with respect to Wang et al.

For the reasons provided above, Cheng et al. differs from Applicant's invention. Cheng et al. does not disclose printing on a hydrophobic substrate. The transparency material disclosed in Cheng et al. is a "transparency material suitable for aqueous ink jet inks or ink jet printing" (col. 15, lines 33-38). The term "suitable for aqueous ink jet inks or ink jet printing" means a coated substrate which has been treated to accept an aqueous ink jet ink. The term transparency as used in Cheng et al., therefore, refers to a coated substrate for receiving an aqueous ink jet ink, not a hydrophobic substrate. Nothing in Miyabayashi et al. cures this deficiency.

Applicant maintains that such claims are patentable in view of the amendments and arguments presented above. Applicant's attorney thanks the Examiner for the time taken to review this response. In view of the foregoing remarks, Applicant respectfully requests reconsideration of the rejection and allowance of the claims. The Examiner is encouraged to contact the attorney listed below if there are any questions or comments.

Respectfully submitted,



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